

providing a knowledge-based game, the knowledge-based game having a plurality of queries,

awarding the player based on answers to the queries,

setting a house advantage for the casino game based on the wager and the player guessing answers.

87. A method for a casino game, said casino game played by a player placing a wager, the method comprising the steps of:

providing a knowledge-based game,

awarding the player based on the player's responses during play of the knowledge-based game,

setting a house advantage for the casino game based on the wager and the player's responses.

REMARKS

In the First Office Action, all of the original 87 claims were rejected variously under 35 U.S.C. § 102, 103, and 112. It is respectfully requested that reconsideration of these claims be made based upon the following arguments. Claims 1, 9, 10 and 42 are amended and the amendments are shown in attached Exhibit D. Also attached herewith as Exhibit A is the PCT Rule 66 WRITTEN OPINION.

35 CFR 1.83(a) Objection

In paragraph 1 of the Office Action, the drawings were objected to as not showing every feature of the invention specified in the claims. Specifically, claims 5-11, 14-18, 48, 49, 55, 56, 59, 60 and etc. were stated. The Applicant was asked to review each claim to be certain that each step is illustrated. It is noted in the cited Keller, Jr. Patent No. 5,718,429 that method steps in claims 3-7, 9-12, and 14-18 are not illustrated in the drawings. Consistency in examination is hereby requested. 35 U.S.C. § 113 (first sentence) provides that an "applicant shall furnish a drawing where necessary for the understanding of the subject matter to be patented" (emphasis added). The applicant has provided sufficient drawings, where necessary, for such an understanding. MPEP § 601.01(g) states:

It has been PTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. § 113 (first sentence).

The pending application fully complies with 35 U.S.C. § 113.

35 U.S.C. § 112 (first paragraph) Rejection

In paragraph 2 of the Office Action, claims 1-87 were rejected under 35 U.S.C. § 112.

The Rejection states:

A method for playing only a knowledge-based game is not disclosed as recited in claims 31, 59, 80, 86, and 87.

The Applicant respectfully disagrees and points to the summary of invention, page 4, lines 15-16, to Figure 3, and to the specification on page 5, lines 7-8. The stand-alone game of the present invention is further discussed on page 40 at lines 9-29. It is maintained that claims 31, 59, 80, 86, and 87 are fully supported and allowance of these claims is respectfully requested.

The Rejection states:

Claims 1-87 are rejected. ... In the specification, the game of chance is played "separately" form [from] the bonus game and is not played in "combination" which implies the games are played simultaneously.

The meaning of this rejection is not known. With respect to underlying casino games and bonus casino games, it is well known in the casino industry that the games are "played" separately and yet are played in combination. For example, the cited Marnell patent (5,393,057) has the underlying casino game played by a player. Upon receiving predetermined results, the player plays a secondary game. Without question, the two games of chance are played in combination with each other which does not infer playing the games simultaneously. In any event, the teachings of the present invention are clear and fully illustrated with examples. In claim 1, for example, it states:

playing a knowledge-based bonus game in combination with the underlying game.

The "combination" play is described in the Specification at page 37, starting at line 17. The word "combination" appears at page 37, line 19. The player first plays the underlying game (page 38, line 7) and upon the appearance of the bonus condition, the play of the underlying casino game stops (Id. at line 10). This triggers the play of the bonus game (Id. at line 25).

Hence, it is maintained that claims 1-87 stand in allowance over the above 35 U.S.C. § 112 rejection.

35 U.S.C. § 112 (second paragraph) Rejection

In paragraph 3 of the Office Action, claims 1-87 are rejected under 35 U.S.C. § 112. The support for "claims ... in combination" is fully explained in the specification at the above passages in the specification already cited which is incorporated by reference.

Claims 9 and 10 have been amended to provide a clear and proper antecedent for "answers" and "queries."

In claim 14, the scope of "approximate answer" is clear as it is set forth, for example, at pages 28-29 in the Specification.

Finally, in claim 60, "the first and second values" have proper antecedent basis. Claim 60 depends from claim 59 which sets forth "a first value" (claim 59, line 5) and "a second value" (claim 59, line 6).

35 U.S.C. § 102(b) REJECTION

In paragraphs 4 and 5 of the Office Action, claims 1-7, 12, 13, 18, 42-46, 50, 55, 57, and 58 were rejected under 35 U.S.C. § 102(b) as being anticipated by Keller and, in the alternative, 2,197,974. Before discussing the rejection, evidence of the state of the art is submitted.

A. Evidence of State of Art Under MPEP 609 c(3)

Attached, as Exhibits B1, B2, C1 and C2 are current articles providing evidence of the state of the art for casino games under MPEP 716.01.

Exhibit B1 is an article "This is JEOPARDY!" which appeared in the October 2000 issue of Strictly Slots. This is a casino game that provides JEOPARDY as a bonus game. As is well known, the knowledge-based TV game show JEOPARDY! asks questions which requires answers from players. The adaptation of JEOPARDY! into a casino game as a bonus game, however, does not require the player to answer questions as in the real TV show! This article states:

For the video version of the game, IGT tapped all the potential of the i-Game Plus format to design a slot game that effectively re-creates the skill

of the TV game show. The bonus rounds in this game simulate segments of the actual show, in a clever and entertaining format. . . .

Video Jeopardy! simulates as much of the show is possible working within the laws of randomness – players cannot be required to answer actual quiz questions. (emphasis added) (Page 61)

In other words, the current state of the art for casino games, that is until the present invention, is to provide to a player what appears to be a knowledge-based game (but actually isn't) as a bonus game to a conventional slot machine. The article continues:

The screen displays the bonus board as categories appearing across the top, just as on the show, with Trebec announcing each one. There are over 100 categories programmed into the software, each with catchy names similar to those in the real show.

Each square on the board bears the familiar "JEOPARDY!" logo, but instead of questions, they hide bonus coin values. The player is prompted to begin picking squares using the touch-screen feature, and the bonus accumulates until one of two "Final Jeopardy" squares is revealed. (emphasis added) (Page 62)

In Exhibit B2, the Jeopardy! game is discussed in an article appearing in Casino Journal, September 1999. The "innovation" of casino games such as Jeopardy! from Anchor Gaming and IGT is discussed (page 60, 3rd paragraph). Yet, Randy Adams, Anchor's Marketing Manager, states that randomness is preserved (i.e., essential to preserve house advantage);

To keep the game based on random chance, the player is prompted to choose from three hidden answers by selecting one of the three "contestants" on the video screen. "Two are correct; one is incorrect." Adams explains. (emphasis added) (page 156, paragraph 4)

In other words, the player "guesses" by selecting a player who then reveals the hidden answer.

The references are evidence of the current state of the art of casino games and is further evidence of the patentability (i.e., the novelty and not obviousness) of the present invention. For the first time, under the teachings of the present invention, a player can use his/her knowledge in a knowledge-based casino game. All of this occurs in a casino game of chance which preserves the house advantage that is fair both to the house and to the player and can be regulated by the appropriate gaming commission.

In Exhibit C1, "Family Feud!" appearing at the Internet site of www.strictlyslots.com on 11/22/00, is a new game from Silicon Gaming that also provides what appears to be a knowledge-based game (but isn't) to a standard underlying slot game. Here, a question is presented to the player, but the player cannot decide which answer to select. There is no player interaction with respect to the questions and the answers except as follows.

The screen displays a survey question, and an image of the answer plaque spins around. The player is prompted to stop it by pushing a button – one of the answers appears, to sounds of audience encouragement such as "GOOD ANSWER!" The answer shouts the familiar, "Survey says ..." If one of the top four answers, it appears with a "ding" on the board, along with a bonus amount corresponding to its rank in the survey. If it is not one of the survey answers, you hear the "buzz" as an "x" slashes over the bonus board. (Page 5)

The player does not select the answer, the player stops a plaque from spinning so as to display an already selected answer. The answer is preselected by the software. In Exhibit C2, Andrew Pascal, President and CEO of Silicon Gaming, states with respect to FAMILY FEUD in the October, 2000 issue of Casino Journal:

Questions in the bonus round are selected at random from a database of over 1,000 questions and answers – all from the actual show during its entire run – compiled by the Silicon development team. Pascal notes that while the player is not guessing the answers, the experience of watching the show is reproduced effectively. (emphasis added) Exhibit C1 at pg. 152.

The present invention is knowledge-based and the player chooses, selects, and/or decides on an answer.

First, these two recent products from recognized companies in the casino industry are solid evidence of the patentability of the present invention. Each of these references are based on a well-known TV knowledge-based game, but the knowledge-based characteristic of a player actually choosing an answer is not present. There is no player interaction wherein the player actually provides the answer to a question as fully claimed in each independent claim of the present invention. The term "knowledge-based" is defined on page 6, lines 14-24 of the specification and is used throughout the specification as the term for a casino game of chance where the player interacts with the game by responding with a response based upon the player's actual knowledge. The present invention as further claimed in each independent claim is a casino game of chance which provides a house advantage in a predetermined range so as to make it a viable casino game which can be

regulated. The FAMILY FEUD references and the JEOPARDY reference are solid evidence of the patentability of the present invention.

Second, the FAMILY FEUD reference also attests to the difficulty of designing casino games of chance with house advantages and, yet the desirability, to have a TV knowledge-based game. Silicon Gaming recognized the difficulty of providing a house advantage (pgs. 3-4 of Exhibit C1) even though all it could achieve was the "look and feel" (pg. 4 of Exhibit C1) of the TV game! Silicon Gaming could not recreate the actual TV knowledge-based game FAMILY FEUD only its "look and feel."

B. Keller

The patent number for Keller was not provided so it is presumed it is U.S. Patent No. 5,718,429 which was provided by the Applicant. The Rejection states:

Claims 1-4, 41-46, 50, 57, and 58 are clearly shown. In Keller and '974, the game of chance stops when a prize has been determined or rewarded. At that point, the game of skill commences.

The Keller, Jr. '429 patent teaches only a skill game and not as a game of chance! The skill game is stated to be "a physical- or a mental- skill game, such as a pool skill- or basketball-shooting, dart-throwing, or trivia answering." (col. 3, lines 1-4). However, Keller admonishes:

The Applicant has developed a method for conducting an entertainment that combines part of the excitement of casino games with the excitement of cash prizes, but which the prevents the casino game from being utilized as a game of chance. (col. 1, lines 41-44) (emphasis added)

The Keller game is designed for use not as a "casino game of chance in a gaming environment," but purely as a skill game such as found in an arcade. Keller further states:

In a traditional casino game, winners are awarded money (or its equivalent, chips) for a successful stake. This allows a player to use or her winnings to pay for continued participation in the casino game. In my method, a winner is not so rewarded. Instead of being awarded money, a winner of a stake in a casino game is awarded one or more tokens that have no redeemable monetary value. (col. 2, lines 32-36) (emphasis added)

Further, the casino game in Keller is played without any wagers being placed or any winners paid. (col. 2, lines 26-28). Keller in adopting a casino game to the arcade environment, requires the casino game not function as a casino game of chance – i.e., no need for a house advantage. C.R. Bard, Inc. v. M3 Systems, Inc., 48 U.S.P.Q.2d 1225 (Fed. Cir. 1998) states:

. . . a finding of anticipation requires that the publications describe all of the elements of the claims, arranged as in the patented device.

Keller fails to teach (1) an underlying game of chance, (2) a house advantage and (3) a house advantage having a predetermined range as found in independent claim 1 (and dependent claims 2-7, 12-13, and 18). Keller fails to teach (1) a first game of chance, (2) the first game of chance having a negative player's expected return, and (3) a second knowledge-based game having a positive player's expected return as found in claim 42 (and dependent claims 43-46, 50, 55, and 57-58). Keller is the exact opposite of and completely teaches away from the claimed invention of a knowledge-based casino game of chance which provides a house advantage. Hence, not only is the '429 Keller patent not a 35 U.S.C. § 102 reference, it is not a § 103 reference since it actually teaches away from the present invention. See Winner Int'l Royalty Corp. v. Wang, 53 U.S.P.Q.2d 1580 (Fed. Cir. 2000).

C. '974A British Application

The '974A application teaches the use of a "fruit machine" only as a random prize generator. The wheels spin and stop in a combination that displays a prize in look-up Table 7. The "possible" prize is awarded upon successful completion of the game of skill (page 4, lines 1-10). The game of skill may comprise a quiz which questions are successively presented on the visual display screen 8, each question accompanied by three possible answers. The player responds and, if correct, the prize indicated in Table 7 would be awarded (page 4, lines 12-23).

This is not the teaching of the present invention. The '974 application uses the underlying fruit machine as a "random prize generator" for the successful completion of the skill-based game. There is nothing in the '974A reference teaching or suggesting a casino game of chance. Rather, this reference, like Keller, is an amusement machine (page 1, lines 3-4). The '974A has no teachings concerning house advantage as is required in casino games. This is not the claimed invention as found in independent claim 1 (and dependent claims 2-7, 12-13, and 18) having (1) a game of chance and (2) a house advantage within (3) a predetermined range. There is no teaching, suggestion, or inference in the '974A application of these claimed features of the present invention. With respect to independent claim 42 (and dependent claims 43-46, 50, 55, and 57-58), there is no teaching, suggestion, or inference in the '974A application of providing (1) a first game of chance having (2) a

negative player's expected return and (3) a knowledge-based game having a positive player's expected return. Hence, the '974A application is not a 35 U.S.C. § 102 (nor a § 103) reference and the claims are patentably distinct there over.

D. Amendments to Claims 1 and 42

Independent claims 1 and 42 have been amended to clarify that the knowledge-based game uses answers from the player. It is maintained that this feature was implicit in the definition of knowledge-based game, but the amendment is made to clarify these claims.

E. Specific Comments Concerning the Remaining Rejections

With respect to the rejection concerning claim 5, for reasons already articulated, Keller does not set forth a gaming machine having a house advantage within a predetermined range. With respect to claim 5 Keller is not a § 102 reference when claim 5 is read into claim 1. The '974A application uses the fruit machine only as the random prize generator for playing the skill game. When claim 5 is read into claim 1, and for the reasons articulated above, the '974A application is not a § 102 reference.

Claim 6 is rejected as follows:

As to claim 6, the game of chance stops at the end of the game.

It is believe that this statement incorrectly interprets claim 6 and, for this reason, the next office action cannot be made final. With respect to claim 6 when read with claim 1, Keller is not a reference for reasons articulated above. The fruit machine in '974A stops to display a prize in Table 7 so that the player can play the skill game. Hence, claim 6 when read with claim 1 is the exact opposite of the teachings of the '974A application.

Claim 7 is rejected as follows:

The end of each game of chance is considered to be a "given frequency" as called for in claim 7.

Again, Keller is not a game of chance as articulated above and when claim 7 is read with claims 3 and 1 is not anticipated or rendered obvious by the '974A application. There is no teaching whatsoever in either Keller or the '974A application of "a given frequency" as defined and set forth in the Specification.

The rejection of claims 12 and 13 states:

A player is "paid" a prize in Keller and the '974A.

As clearly taught in the Specification, paying occurs in the gaming environment based on wagers which is the direct opposite of the Keller arcade game. The '974A application pays a random prize. When claim 12 is read with independent claim 1, for the reasons articulated above, the Keller and the '974A application do not provide (1) a house advantage or (2) a house advantage within a predetermined range as set forth. Claim 13 depending from claim 12, likewise, is patentably distinct.

Claims 18, 41, and 55 are also rejected based upon:

A player is paid a first prize if correctly answers and receives a second amount of no prize if incorrectly answers.

Claim 18 depends from claim 12 and the reasons articulated with respect to claim 12 for both Keller and the '974A application are equally applicable here and this claim is patentably distinct. Claim 41 depends from claim 35 which in turn depends from claim 31. Claims 31, 35 and 41 are rejected in paragraph 5 and, for this reason alone, the next office action cannot be made final. It is respectfully requested that this be clarified. For reasons explained in the following 35 U.S.C. § 103 response, independent claim 31 is not rendered obvious by either Keller or the '974A application. Claim 55 depends from claim 50 which in turn depends from claim 42 and, for reasons articulated above, claim 55 is patentably distinct. Claim 55 pays first and second amounts based upon paying negative player's expected return and the positive player's expected return as set forth in claim 42. There is no teaching in Keller of "paying" and there is certainly no teaching in Keller or the '974A application of the positive and negative expected returns as fully explained in the Specification and set forth in independent claim 42.

Claims 1-7, 12, 13, 18, 42-46, 50, 55, 57 and 58 are not anticipated under 35 U.S.C. § 102(b) by Keller or, in the alternative, by the '974A application. These two references also do not render obvious these claims and these claims are patentably distinct and their allowance is respectfully requested.

35 U.S.C. § 103(a)

Claims 8-11, 14-17, 19-40, 47-49, 51-54, 56 and 59-87 were rejected in paragraphs 6 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Keller and/or 2,197,974 in view of Thompson.

All of the arguments with respect to Keller set forth above equally apply here. Keller is simply an arcade game and, by its own admission, has no applicability in the world of wagering and gaming as it is designed never to issue monetary awards. Hence, in each of the above claims there is no teaching in Keller of a house advantage or any concern whatsoever for a house advantage. Hence, Keller under Winner Int'l Royalty, supra cannot be a 35 U.S.C. § 103 reference and these claims are patentably distinct over Keller.

With respect to the '974A application, all of the arguments set forth above are incorporated herein by reference, and the '974 application is maintained not to be a 35 U.S.C. § 103 reference. Specifically, the underlying fruit machine is simply a random prize generator to generate prizes for the player to play the game of skill. There is nothing in the '974A application teaching the claimed features of the present invention.

The Rejection states:

As to claims 8, 47, and 61, neither of the above references show random stopping of the chance game. Thompson teaches that it would have been obvious to random conduct the steps of a game like those shown in Keller and the '974 patent in order to add an element of surprise to the players.

Claims 8 and 47 are dependent claims wherein stopping the underlying game of chance is randomly chosen at a given frequency. Claim 61 is different in that it requires the player to place a second wager to play the knowledge-based game in response to random activation. Random activation of independent claim 60 is at a given frequency. The concept of "frequency" under the teachings of the present invention is defined in the specification (see, for example, page 14). The frequency affects the determination of the house advantage. There is no discussion, suggestion, or inference in Keller or the '974 reference of "house advantage" or of such "a frequency." It is presumed that the Thompson reference is U.S. Patent 5,178,545. This patent is not a casino gaming invention and, therefore, like Keller has no need for house advantage concerns or considerations. Thompson is an educational game (col. 1, line 7). There is no stopping of the underlying casino game of chance at a given frequency in Thompson. Claims 8, 47 and 61 do not go to the play of the knowledge-based game in a random fashion as suggested in the above Rejection, but go to the random stopping of the underlying game of chance so the player can play the knowledge-based game of the present invention. None of these references teach a "given frequency" for stopping the underlying game of chance and, therefore, each of these dependent claims and their corresponding intervening and independent claims stand patentably distinct for this

reason alone, over all three of the cited references taken individually or in combination with each other.

The Rejection further states:

The setting of the house advantage in claims 9-11, 19, 20, 25-35, 48, 49, 56, 59, 60, 62, 64 and 65-69 are obvious matters of design choice.

It is respectfully requested that strict proof based on objective evidence be submitted to support the above conclusionary statement under MPEP 707.07(g). Exhibits B1, B2, C1 and C2 attest to the current state of the art which provides objective evidence contrary to the above conclusionary statement. It is maintained that each of the three references of Keller, '974A, and Thompson do not teach, suggest, or infer such house advantages as claimed in the corresponding independent claims and the specifically cited claims. Rather, it is maintained that this Rejection of this important claimed feature is based upon piecemeal examination using hindsight and the thorough teachings of the pending application – all of which is not permitted under MPEP 707.07(g). The next office action cannot be made final as Applicant must be afforded the opportunity to respond to any newly presented objective evidence. All references are totally silent on the following features:

Claims 9, 19 and 32 – house advantage based on answers all being correct.

Claims 10 and 37 – house advantage based on answers all being guessed at.

Claims 11 and 34 – house advantage range between about –3% to about 20%.

Claims 25 and 59 – house advantage in a range based on all answers correct and guessed at.

Claims 29 and 60 – step of playing at a given frequency.

Claim 30 – step of playing randomly chosen at a given frequency.

Claim 31 – house advantage within a predetermined range.

Claims 48, 49 and 56 – positive player's expectation.

The Rejection continues:

As to claims 14, 21, and 22, it is considered an obvious matter of design choice to require either an exact answer or approximate answer that is "close enough."

Again, it is respectfully requested that solid objective evidence of obviousness be provided. Indeed, there is no discussion in either Keller or the '974A application of a "skill game" responding to an approximate answer or an answer that is "close enough." Again, this Rejection, absent solid objective evidence, is conclusionary based upon hindsight and the

teachings of the present specification as found in these claims. The next office action cannot be made final as Applicant must be afforded the opportunity to respond to any newly presented objective evidence.

The Rejection further states:

Similarly, allowing a player to have more than on [one] chance to answer a query and paying accordingly is called for in claim 63 is old and not considered advanced in the art.

Again, solid objective evidence is requested. It is clear the two references to Keller and '974 do not provide this feature. The next office action cannot be made final as Applicant must be afforded the opportunity to respond to any newly presented objective evidence. Furthermore, claim 63 when read in conjunction with intervening claim 62 which, in turn, is read with independent claim 59 is patentably distinct over the cited references.

The Rejection further states:

To have only required a [an] approximate answer in Keller of '974 would have been obvious in order to make it easier on the player.

It is not known which claim(s) this Rejection applies to, but is assumed to apply to claims 14, 21, and 22 and the aforesaid argument with respect to those claims is incorporated herein by reference.

The Rejection further states:

As to claims 15-17, 23, 36-40, and 51-54, Keller and the '974 show "trivia" and a "quiz." Multiple choice, puzzles and true/false questions are all well known [known] examples of such trivia or quiz type games of skill that are known in the art. To have selected one would have been an obvious matter of design choice.

The Applicant agrees that trivia and quiz games are well known as well as multiple choice, puzzles, and true/false questions as is presented in the Statement of the Problem section of the Specification. The application of such well known knowledge-based games has been absent from the casino gaming world. The reason for this absence as explained in the Specification of the present invention is that such well-known games cause an unacceptable loss to the house, that is, until the teachings of the present invention. Hence, these claims, when read with their intervening claims and independent claims are patentably distinct over the cited references.

The Rejection further states:

Claim 24 is shown in that a player is payed [paid] a first prize if correctly answers and receives a second amount of no prize if incorrectly answers.

It is not known what the 35 U.S.C. § 103 basis for the rejection of claim 24 is. However, this is an accurate statement of claim 24 and is patentably distinct from the cited reference as neither Keller, the '974A application, nor Thompson teach, suggest, or infer this feature.

The Rejection further states:

Claims 70-79 and 82-85 are old to trivia type games.

It is respectfully maintained that the above statement is incorrect especially when the dependent claims are read with their intervening and independent claims. For example, in claim 71, a lamer is specifically claimed which has no application to trivia type games.

Finally, the Rejection states:

Claims 80, 81, 86 and 87 are treated as set forth above.

All of the above Rejections set forth above are also incorporated by reference. Claims 31, 80, 86 and 87 specifically claim a stand-alone casino game. As mentioned, Keller is not a gaming machine and has no application as a casino game. The '974A application has no teaching for a stand-alone knowledge-based casino game having a house advantage based upon the wager and the player having all correct answers. Thompson does not teach anything about a casino game, house advantage, wagers, etc.

Prior Art Made of Record, But Not Relied Upon

The Applicant agrees that all of the claims are patentably distinct over Marnell.

Conclusion


For these reasons set forth above, all pending claims are patentably distinct over the references cited and allowance of claims is respectfully requested.

Should you have any questions regarding the above, please feel free to give the below-listed attorney a call. If additional fees are required, please debit our Deposit Account No. 04-1414.

Respectfully submitted,

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